

Remarks

Favorable reconsideration of the above-identified application in view of the present response is respectfully requested. Claims 14-35 are pending. Claims 14-20 and 22-35 are rejected and claim 21 has been allowed. By this paper, Applicants have added new claims 36-40. No new matter has been added by virtue of the present amendments.

With respect to the Examiner's rejection of claims 14-20 under 35 U.S.C. § 102(a), as being anticipated by U.S. Patent No. 5,935,364 to Groendal *et al.* (*Groendal*), Applicants traverse this rejection and respectfully request that it be withdrawn. The law is clear that anticipation under 35 U.S.C. § 102 "requires that each and every element of the claimed invention be disclosed in the prior art." *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ2d 1241, 1245 (Fed. Cir. 1996), *cert. denied*, 482 U.S. 909 (1987). *Groendal* does not disclose the "preformed composite pad" required by claims 14-20. In the July 25, 2003 Office Action, the Examiner states that *Groendal* does disclose a preformed composite pad because "Groendal teaches all the components thereof are held together in the mold. The moment just right before the upholstered article is formed, a foam cushion layer and a topping layer together are considered as a preformed composite in the mold." *See*, July 25, 2003 Office Action, ¶ 2.

This reasoning shows a misunderstanding of the claim term "preformed composite pad." A composite pad is a unitary pad comprising two or more connected layers. A preformed composite pad is a unitary pad comprising two or more connected layers whose layers are connected in advance of whatever process or use is envisioned by the invention.

Groendal does not teach such a unitary pad. On the contrary, *Groendal* teaches an arrangement of separate, distinct and unconnected layers arranged adjacent to one another. These separate layers do not become connected until after the process described in *Groendal* occurs. At any point prior to the application of heat in *Groendal*, the adjacent layers are separated and can be moved with respect to one another. In fact, the invention of *Groendal*

relies on the ability to separate and readjust these layers to practice the invention of *Groendal*. As stated in *Groendal*'s abstract, “the fabric on the preassembled upholstered article can be adjusted, such as to remove wrinkles. Thereafter, heat can be applied to the preassembled upholstered article to activate thermally activable adhesive disposed between the article and the upholstery fabric to cause the upholstery fabric to be permanently adhered to the article. The process allows the fabric covering to be adjusted before the fabric is permanently adhered to the article . . .” *See, Groendal, Abstract.*

As *Groendal*'s abstract and *Groendal*'s entire disclosure make clear, the pad disclosed in *Groendal* is not a unitary pad comprising two or more layers which are connected until after the process disclosed by *Groendal* is completed. Thus, it is not “preformed,” and accordingly *Groendal* does not disclose a “preformed composite pad.” Consequently, *Groendal* does not disclose every element of claims 14-20 as required by 35 U.S.C. § 102. Applicants contend that claims 14-20 are now in condition for allowance and respectfully request a notice to that effect.

Even if the Examiner remains unconvinced regarding *Groendal*'s failure to disclose each and every element of claims 14-20, there can be no doubt that *Groendal* fails to disclose each element of new claim 36. New claim 36 depends from claim 14, and recites an additional limitation that the respective layers of the preformed composite pad are connected to one another. As discussed above, *Groendal* does not disclose a preformed composite pad where the various layers of the composite pad are connected to one another. On the contrary, as the portion quoted from *Groendal*'s abstract, above, makes clear, to practice the invention of *Groendal*, the respective layers of the upholstered pad must not be connected to one another. Accordingly, Applicants submit that claim 36 is in condition for allowance and respectfully request a notice to that effect.

With respect to the Examiner's 35 U.S.C. § 112, first paragraph rejection of claims 22-35, Applicants traverse this rejection and respectfully request that it be withdrawn. The Examiner bears the burden of providing a *prima facie* case to support a rejection of a

patent application under 35 U.S.C. § 112, first paragraph. As the Federal Circuit stated in *In re Oetiker*, “[i]f the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of the patent.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Accordingly, the Examiner has the burden of showing that the application is non-enabling. As the Federal Circuit stated:

When rejecting a claim under the enablement requirement of Section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application

In re Wright, 999 F.2d 1557, 1561-1562 (Fed. Cir. 1993).

The Federal Circuit has made clear what the Examiner must show to establish its *prima facie* case of non-enablement under 35 U.S.C. §, first paragraph:

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented **must** be taken in as in compliance with the enabling requirement of the first paragraph of Section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

Fiers v. Revel v. Sugano, 984 F.2d 1164, 1171-1172 (Fed. Cir. 1993) (emphasis added).

In other words, the Examiner **must** show that the rejected claim language does not correspond to the language used in the specification to describe the claimed invention. If the claim language does correspond to the description in the specification which defines the subject matter of the claim, then, as a matter of law, the claim is objectively enabled and the patent must be deemed to be in compliance with 35 U.S.C. § 112, first paragraph. In that case (which is the case here), the Examiner **must** articulate some reason to doubt the objective truth of the statements contained in the specification.

In the July 25, 2003 Office Action, the Examiner states that “[c]laims 22-35 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while it is enabling for a composite wherein the impregnable layer is a porous, and reticulated material and non-impregnable layer is an elastomeric, foam-like material, it does not reasonably provide enablement for the claimed material wherein the nature of the impregnable and non-impregnable layers are not specified.” *See*, July 25, 2003 Office Action, ¶ 4. However, the Examiner states no basis for this assertion. This is improper in view of the fact that the claim language is objectively supported by the specification. In the pending application, claims 22 and 29 are independent claims, each reciting “a composite pad comprising a non-impregnable layer and an impregnable layer.” Claims 23-28 and claims 30-35 depend from claims 22 and 29, respectively. The Examiner’s 35 U.S.C. § 112, first paragraph rejection is based on claim 22’s and 29’s recitation of “a composite pad comprising a non-impregnable layer and an impregnable layer.” However, this rejected claim language is objectively supported by the specification which states that “[t]he composite pad 20, as best shown in Figure 2, comprises an impregnable layer 30 and a non-impregnable layer 32.” *See*, Applicants’ initial application, p. 5, ll. 3-5 (emphasis added). Because the claim language precisely corresponds with the description in the specification, claims 22-35 are objectively supported and enabled by the specification. As a matter of law, claims 22-35 are enabled. *Fiers*, 984 F.2d at 1171-1172.

In view of this objective enablement, it is the Examiner’s burden to provide some “reason to doubt the objective truth of the statements contained [in the specification] which must be relied on for enabling support.” *Fiers*, 984 F.2d at 1172. The Examiner has not offered **any** reason to doubt the objective truth of the statements in the specification, quoted above. Instead, the Examiner simply offers an unsupported and conclusory assertion that the disclosure is not enabling. The Federal Circuit has made clear that this sort of rejection, in the face of an objectively supported claim, is insufficient. Accordingly, the Examiner has failed to establish a *prima facie* case that the specification lacks enablement under 35 U.S.C. § 112, first paragraph.

Furthermore, the sufficiency of the specification's enablement is manifest. To be enabling, an application must explain how to make and use the invention to **one of ordinary skill in the art**. As the Federal Circuit has stated, a "person of ordinary skill is a hypothetical person **who is presumed to be aware of all the pertinent prior art.**" *Custom Accessories Inc. v. Jeffrey-Allan Indus.*, 807 F.2d 955, 962 (Fed. Cir. 1986) (emphasis added). Accordingly, specifications need only to be reasonable with respect to the art involved; they need not educate the layman nor disclose what a skilled artisan already knows. *Loom Co. v. Higgins*, 105 U.S. 580, 585 (1882). The question is "whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention, hence the specification need not disclose what is well known in the art." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984).

With respect to the present invention, one of ordinary skill in the art would read the specification and understand that the invention requires the use of a composite pad, the impregnable portion of which would allow molten substrate material to flow through it, while the non-impregnable portion of the composite pad would not. More specific information is not required to satisfy 35 U.S.C. § 112, first paragraph. Accordingly, Applicants contend that claims 22-35 are in condition for allowance and respectfully request a notice to that effect.

Even if the Examiner remains unconvinced that claims 22-35 are objectively enabled, there can be no doubt that new claims 37 and 38, which depend from claim 22, and new claims 39 and 40, which depend from claim 29, obviate the Examiner's rejection. Claims 37 and 39 recite a composite pad wherein the impregnable layer is limited to a reticulated material and the non-impregnable layer is limited to an elastomeric foam-type material. Claims 38 and 40 recite a composite pad wherein the impregnable layer is limited to a porous material, and the non-impregnable layer is limited to an elastomeric foam-type material. Accordingly, Applicants submit that claims 37-40 are in condition for allowance and respectfully request a notice to that effect.

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Applicants note with appreciation the indication that claim 21 is allowed. In light of this response, and having addressed all of the rejections raised in the July 25, 2003 Office Action, Applicants submit that this entire application is now in condition for allowance and respectfully request a notice to that effect. If the Examiner believes that a further telephone conference will advance the prosecution of this application, such a conference is invited at the convenience of the Examiner.

A check in the amount of \$90.00 is enclosed to cover the additional claims filing fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of the Amendment Transmittal is enclosed for that purpose.

Respectfully submitted,

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